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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,548	11/20/2001	Lennart Olsson	213542000101	4181

25226 7590 03/25/2003

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EXAMINER

DIBRINO, MARIANNE NMN

ART UNIT PAPER NUMBER

1644

DATE MAILED: 03/25/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/991,548

Applicant(s)

OLSSON ET AL.

Examiner

DiBrino Marianne

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/2/02 & 11/20/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8,9 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 8, 9 and 37-46 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 8, 9, 37-40, 42, 44 and 46, drawn to a method of modulating the activity of a cell surface receptor comprising a contacting step in the absence of exogenous ligand and wherein the level of receptor activation is increased, classified in Class 514, subclass 2 .

II. Claims 8, 9, 37-39, 41, 42,44 and 46, drawn to a method of modulating the activity of a cell surface receptor comprising a contacting step in the presence of exogenous ligand and wherein the level of receptor activation is increased, classified in Class 424, subclass 185.1 .

III. Claims 37-40, 43, 45 and 46, drawn to a method of modulating the activity of a cell surface receptor comprising a contacting step in the absence of exogenous ligand and wherein the level of receptor activation is decreased, classified in Class 514, subclasses 12 and 13.

IV. Claims 37-39, 41, 43, 45 and 46, drawn to a method of modulating the activity of a cell surface receptor comprising a contacting step in the presence of exogenous ligand and wherein the level of receptor activation is decreased, classified in Class 424, subclass 185.1 and Class 514, subclasses 12 and 13.

2. These inventions are distinct, each from the other because:

Inventions I, II, III and IV are different methods.

~~These inventions require different ingredients, process steps and endpoints. For example, the method of Groups I and III require a contacting step with an exogenous compound in the absence of an exogenous ligand, whereas the method of Groups II and IV require in addition an exogenous ligand. The methods of Groups I and II require increase in receptor activation, whereas the methods of Groups III and IV require decrease in receptor activation.~~

3. Because these inventions are distinct for the reasons given above and the search required for any group from Groups I-IV is not required for any other group from Groups I-IV and Groups I-IV have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

4. This application contains claims directed to the following patentably distinct species of the claimed Groups I, II, III and IV:

A) a cell surface receptor selected from the group consisting of those recited in claim 46.

B) an exogenous compound, one of SEQ ID NOS: 1-44

C) an exogenous ligand, one of SEQ ID NOS : 1-44

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These species of cell surface receptor are distinct because their structures and modes of action are different.

These species of peptides represented by SEQ ID NOS: 1-44 are distinct because their physico-chemical properties are different.

If the exogenous compound is not one of SEQ ID NO: 1-44, Applicant is requested to elect a single disclosed species of non-peptide ligand disclosed in the specification.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

5. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant ~~should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case.~~ In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 of the other invention.

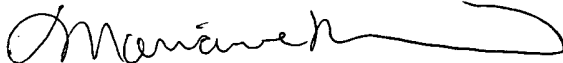
6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. 1.48(b) and by the fee required under 37 C.F.R. 1.17(h).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne DiBrino whose telephone number is 703-308-0061. The examiner can normally be reached on Monday and Thursday from 11 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



Marianne DiBrino, Ph.D.  
Patent Examiner  
Group 1640  
Technology Center 1600  
March 20, 2003



PATRICK J. NOLAN, PH.D.  
PRIMARY EXAMINER

3/24/03